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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,552	02/14/2002	Takashi Shigetomi	8694.44USD1	3925

23552 7590 09/16/2004

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EXAMINER

GRAYBILL, DAVID E

ART UNIT	PAPER NUMBER
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2822

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/077,552	Applicant(s) SHIGETOMI ET AL.	
	Examiner David E Graybill	Art Unit 2827	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/001,139.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3 pages</u> . | 6) <input type="checkbox"/> Other: _____ |

The information disclosure statement filed 2-14-2 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because reference, "IBM Journal TDB, June 1992, pp 311-314." is not sufficiently identified. It has been placed in the application file, but reference, "IBM Journal TDB, June 1992, pp 311-314." has not been considered as to the merits.

Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

In the rejections *infra*, generally, reference labels are recited only for the first recitation of identical claim elements.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless – (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-13 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Feamster (5235586).

At column 3, line 67 to column 4, line 24; column 5, lines 24-35; column 5, line 55 to column 6, line 17; column 7, line 67 to column 8, line 42; column 8, line 67 to column 9, line 3; and column 9, line 63 to column 10, line 10, Feamster discloses the following:

A method for manufacturing a storage medium where electronic circuits are mounted, comprising: a step of manufacturing an information recording surface 12 for recording information; a step of manufacturing an electronic-circuit mounting surface 14 including said electronic circuits 302 at least on one portion; and an inherent step of attaching said information recording surface to said electronic-circuit mounting surface.

The method for manufacturing a storage medium where electronic circuits are mounted, comprising: a step of manufacturing an information recording surface for recording information; and a step of forming an electronic-circuit mounting surface including said electronic circuits at least on one portion, on the rear surface of said information recording surface.

A method for manufacturing a storage medium where electronic circuits are mounted, comprising: a step of manufacturing an electronic-circuit mounting surface including said electronic circuits at least on one portion; and a step of forming an information recording surface for recording information, on the rear surface of said electronic-circuit mounting surface; wherein said storage medium includes a magnetic disk, a magnetic card, an

optical disk such as a CD or a DVD, a magneto-optical disk such as an MO, an optical card or a magneto-optical card.

To further clarify, the step of attaching is inherent in the process of Feamster because Feamster discloses that the surfaces are attached.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14, 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feamster as applied to claims 11-13 and 26, and further in combination with Kitano (5744193).

Feamster does not appear to explicitly disclose wherein said step of manufacturing said information recording surface includes: a step of injecting a base; a step of forming a reflection film on said base; and a step of coating said reflection film with a protective film.

Nonetheless, at column 4, lines 16-33, Kitano discloses this process. Moreover, it would have been obvious to combine this disclosure of Kitano with the disclosure of Feamster because it would facilitate provision of the information recording surface of Feamster.

Claims 15-17, 19-21 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feamster as applied to claims 11, 12 and 13, and further in combination with Jacobs (5192716).

Feamster does not appear to explicitly disclose the following:

The method according to claim 11, wherein said step of manufacturing said electronic-circuit mounting surface includes; a step of mounting the electronic circuit; and a step of coating or forming a protective film or layer over said electronic circuit; a step of forming a conductive wiring; a step of forming a silicon wafer, a ceramic substrate or an insulating substrate; and a step of forming a semiconductor circuit on said silicon wafer, ceramic substrate or insulating substrate.

Nevertheless, at column 6, lines 43-55; and column 7, line 11 to column 9, line 17, Jacobs discloses wherein a step of manufacturing an electronic-circuit mounting surface includes; a step of mounting the electronic circuit 25; and a step of coating or forming a protective film 15 or layer over said electronic circuit; a step of forming a conductive wiring 16; a step of forming a silicon wafer, a ceramic substrate or an insulating substrate 20; and a step of forming a semiconductor circuit 25 on said silicon wafer, ceramic substrate or insulating substrate. In addition, it would have been obvious to combine this disclosure of Jacobs with the disclosure of

Art Unit: 2827

Feamster because it would facilitate provision of the electronic-circuit mounting surface of Feamster.

The art made of record and not applied to the rejection is considered pertinent to applicant's disclosure. It is cited primarily to show inventions similar to the instant invention.

For information on the status of this application applicant should check PAIR:

Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alternatively, applicant may contact the File Information Unit at (703) 308-2733. Telephone status inquiries should not be directed to the examiner. See MPEP 1730VIC, MPEP 203.08 and MPEP 102.

Any other telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (571) 272-1930. Regular office hours: Monday through Friday, 8:30 a.m. to 6:00 p.m.
The fax phone number for group 2800 is (703) 872-9306.



David E. Graybill
Primary Examiner
Art Unit 2827

D.G.
9-Sep-04